

209313US3 PCT



Election 11
S. Zimmerman
11-21-02

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

Kenichi OTANI, et al.

: EXAMINER: MAI, T.

SERIAL NO: 09/868,040 :

FILED: July 23, 2001

: GROUP ART UNIT: 3727

FOR: MOLDED ARTICLE :

PROVISIONAL ELECTION OF SPECIES

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RECEIVED

NOV 14 2002

TECHNOLOGY CENTER R3700

SIR:

In response to the Election of Species requirement dated September 11, 2002, the Applicants provisionally elect with traverse the species of Group I corresponding to Figures 1, 2, and 3, and identifies Claims 11, 12, 15, and 17 as readable on the provisionally elected species.

The Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "[t]his application contains claims directed to ... patentably distinct species ..." without stating any basis whatsoever in support of such a finding. This is in violation of MPEP § 816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually exclusive. ..

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

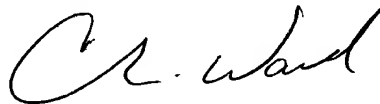
... If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, the Applicants also respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 11-34 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record

Christopher D. Ward
Registration No. 41,367



22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 11/98)

GJM/CDW/brf

I:\atty\cdw\209313US3PCT\election.wpd